

REMARKS

Claims 9-26 are pending. No new matter has been added by way of the present amendment. For instance, claims 1-8 have been cancelled and claims 9-26 have been added. The newly added claims are supported as outlined in the following Table:

| Claim | Location of Support in Present Specification and/or Original Claims |
|-------|---|
| 9 | Original claims, page 10, lines 19-25, page 12, lines 23-27, and page 16, lines 4-20. |
| 10 | Page 12, lines 23-25. |
| 11-12 | Page 7, line 9. |
| 13-14 | Page 10, line 27 to page 11, line 2. |
| 15-20 | Original claim 4. |
| 21 | Original claim 2. |
| 22 | Page 12, lines 23-25. |
| 23-24 | Original claim 4. |
| 25-26 | Pages 16-20. |

Enclosed herewith in full compliance with 37 C.F.R. §§1.821-1.825 is a Substitute Sequence Listing to be inserted into the specification as indicated above. The Substitute Sequence Listing in no way introduces new matter into the specification. Also submitted herewith in full compliance with 37 C.F.R. §§1.821-1.825 is a disk copy of the Substitute Sequence Listing. The disk copy of the Substitute Sequence Listing, file "2004-12-07 0020-

4879P.ST25.txt", is identical to the paper copy, except that it lacks formatting.

As requested by the Examiner, the nucleotide sequence disclosed on page 11, lines 17-18 of the specification as filed has been included in the substitute Sequence Listing enclosed herewith. The specification has also been amended to identify this sequence by its sequence identifier number, SEQ ID NO: 5. No new matter is introduced by these amendments.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Election/Restriction

At page 2 of the outstanding Office Action, the Examiner has maintained the Restriction Requirement, asserting that the different groups of inventions include distinct technical features. Applicants respectfully disagree with the Examiner. Ignoring the fact that claim 7 is no longer pending, there was never any need to withdraw this subject matter from consideration.

All of the claims as presently recited, as well as originally filed, are based upon a single general inventive concept under PCT Rule 13.1. The Examiner has misinterpreted the rules concerning Unity of Invention rules, which do not require that a group of claims share every technical feature, just that they share a single

general one that is the inventive concept.

The Examiner does properly indicate that, based upon his views, the special technical feature urged to link the groups of claims is not patentable and therefore cannot serve as a feature that establishes Unity of Invention. However, Applicants disagree with the Examiner's view of patentability of that special technical feature as argued below. Thus, Applicants again urge the Examiner to search and consider all currently pending claims.

Objections to the Specification

The Examiner has objected to the specification for the reasons recited at pages 3-4 of the outstanding Office Action. Applicants respectfully traverse.

First, the Examiner objects to the specification stating that the claims must be preceded by a phrase such as "What is claimed is:". Applicants submit that such an amendment has been entered.

Second, the Examiner has objected to the specification stating that a nucleotide sequence is missing from the Sequence Listing. As discussed in the above pages, this issue has been rectified by including the nucleotide sequence disclosed on page 11, lines 17-18 of the specification into the substitute Sequence Listing enclosed herewith. The specification has also been amended to identify this sequence by its sequence identifier number, SEQ ID NO: 5.

Objection to claim 5

The Examiner has objected to claim 5 asserting that it refers to non-elected subject matter. Applicants traverse and submit that claim 5 has been cancelled. Further, as discussed above, this issue should be moot since Applicants disagree with the Examiner's outstanding restriction requirement. Thus, Applicants submit that examination of an embodiment of originally filed claim 5 (directed to identification of an antagonist) is appropriate in the instant application.

Issues under 35 U.S.C. § 101

The Examiner has rejected claim 5 under 35 U.S.C. § 101 asserting that the recitation of a "use" without setting forth any steps involved in the process results in an improper definition of a process. Applicants respectfully traverse and submit that claim 5 has been cancelled. Moreover, none of the newly added claims relate to a process without setting forth steps involved in the process. Accordingly, this rejection is moot. Reconsideration and withdrawal thereof are respectfully requested.

Issues under 35 U.S.C. § 112, second paragraph

The Examiner has rejected claims 1-6 and 8 under 35 U.S.C. § 112, second paragraph for the reasons recited at pages 5-6 of the outstanding Office Action. Applicants respectfully traverse.

Claims 1-6 and 8 are cancelled. Moreover, all of the presently pending claims fully satisfy the requirements of 35 U.S.C. § 112, second paragraph. Accordingly, these rejections are moot. The Examiner is therefore respectfully requested to withdraw these rejections.

Issues under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-6 and 8 under 35 U.S.C. §103(a) as being obvious over Bradfield, USP 5,650,283 (hereinafter referred to as Bradfield '283) or Bradfield, USP 6,432,692 (hereinafter referred to as Bradfield'692) in view of Moore, USP 5,846,711 (hereinafter referred to as Moore '711). Applicants respectfully traverse.

The Examiner cites Bradfield '283 and Bradfield '692 for allegedly disclosing the features of the invention concerning two "reporter genes" that are present and can be expressed in the same cell. As required by the present invention, transcription of the first reporter is controlled by a promoter that is responsive to a ligand-mediated transcription factor. The second reporter is controlled by a constitutive promoter. However, neither of the Bradfield references suggests or discloses this subject matter. Applicants will discuss this further below.

The Examiner notes that one of the "reporter genes" as disclosed by Bradfield is, in fact, a selectable marker gene. The

Examiner asserts that a marker gene can be a "reporter gene" as their expression "can be easily detected" (last line at page 7 of the Office Action). The Examiner deems this a reasonable interpretation of the reference.

However, Applicants respectfully submit that the interpretation of the Examiner is not reasonable since it is directly contrary to the express teachings of the Bradfield '692 reference. At col. 7, lines 39-45, a "selectable marker gene" and a "reporter gene" are given expressly distinct definitions. Thus, the Examiner has improperly equated two things that the inventor plainly envisions as distinct.

Further, Applicants note that a "selectable marker gene" as exemplified by Bradfield is one that can be easily detected in a qualitative fashion. However, the presently claimed invention requires the quantitative nature of the activity of two "reporter genes". The present invention uses a second reporter gene to provide a basis for normalizing the activity of the first reporter gene, so that an effect of a compound on the activity of a ligand-mediated transcription factor can be more easily and reliably observed. This entire concept is absent from the Bradfield references, therefore, Applicants submit that the references fail to suggest or disclose the currently claimed subject matter.

Additionally, the secondary reference fails to cure these deficiencies. As explained by the Examiner, Moore '711 is cited

only for the feature of chromosomal integration of the two reporter gene constructs. Applicants submit that Moore '711 does not remedy the defects of the two Bradfield references relating to the absence of a suggestion or disclosure of the quantitative normalization aspect of the present invention. Therefore, the combination of Moore '711 with either Bradfield reference is insufficient to establish *prima facie* obviousness of the present invention.

In summary, Applicants respectfully submit that the Examiner has failed to present a valid *prima facie* case of obviousness. The present application fully supports and claims patentable subject matter. Thus, a favorable action of allowance of the pending claims and passage of the application to issue is respectfully requested.


Pursuant to the provisions of 37 C.F.R. §§ 1.17 and 1.136(a), Applicants respectfully petition for a three (3) month extension of time for filing a response in connection with the present application. The required fee of \$1,020.00 is attached hereto.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Mark J. Nuell (Reg. No. 36,623) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment(s): Paper and Computer readable copies of Substitute
Sequence Listing